

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
James K. Prueitt, *et al.*

Confirmation No.: **1320**

Application No.: **09/870,538**

Group Art Unit: **2143**

Filing Date: **May 30, 2001**

Examiner: **Joseph E. Avellino**

For: **Method and System for Generating a Permanent Record of a Service Provided to a Mobile Device**

Mail Stop Appeal Brief -- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPELLANT'S REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

Appellants submit this Reply in response to the Examiner's Answer dated August 21, 2007 in connection with the above-identified application. This reply is being filed within two months of the Examiner's Answer. An Appeal Brief was timely filed on July 10, 2007 in support of Appellants' appeal from the final rejection of claims 1 to 5, 7 to 9, 11 to 15, 17 to 20, 22 to 28, and 30 mailed September 14, 2006. A Notice of Appeal was timely filed on December 13, 2006.

1. REAL PARTY IN INTEREST

The real party in interest is Senshin Capital, LLC, a limited liability company of the state of Delaware, with a registered address of 2711 Centerville Road, Suite 400, Wilmington, Delaware 19808 USA and principal office at Temasek Boulevard, #44-01 Suntec Tower One, Singapore 038987.

2. RELATED APPEALS AND INTERFERENCES

No related appeals or interferences are pending. See appendix entitled RELATED PROCEEDINGS APPENDIX.

3. STATUS OF CLAIMS

Pending	:	Claims 1 to 5, 7 to 9, 11 to 15, 17 to 20, 22 to 24, 30, 38, and 39
Rejected	:	Claims 1 to 5, 7 to 9, 11 to 15, 17 to 20, 22 to 24, 30
Objected to	:	None
Allowed	:	None
Withdrawn	:	Claims 38 and 39
Appealed	:	Claims 1 to 5, 7 to 9, 11 to 15, 17 to 20, 22 to 24, and 30.

The appealed claims are listed in the appendix entitled CLAIMS APPENDIX.

4. STATUS OF AMENDMENTS

No claim amendments were filed subsequently to Final Rejection.

5. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed invention is generally directed to a method and a system for providing users of mobile digital devices the opportunity to obtain a permanent record of a service originating at the mobile device and not related to the location of the device. The method provides a service at a mobile device and generates, at the location of the mobile device, a permanent record of the service, the service and the permanent record being processed by at least one of many remote servers.

Independent claim 1 is directed to a method of providing a service at a mobile device and generating, at the location of said mobile device, a permanent record of said service, said service and said permanent record being processed by at least one of a plurality of remote servers, said method comprising the steps of:

- (A) receiving at a receiving center, from the mobile device, a request for the service and information identifying a specific printer on which service related data is to be printed at the location of the mobile device (Figure 7, 200);
- (B) providing, from the receiving center, data for the request to a service server, said service server being one of said at least one of a plurality of remote servers (Figure 7, 210);
- (C) processing the request for service at the service server, said processing generating the data for the service (Figure 7, 110);

- (D) providing said data for the service to a printing server, said printing server being one of said at least one of a plurality of remote servers and including stored print data for optimizing the quality of prints printed on various specific printers (Figure 7, 140);
 - (E) processing, at the printing server, said service data and stored print data for the identified specific printer to generate input data for the specific printer in a *manner to produce the optimal quality print for the specific printer* (Figure 7, 170);
 - (F) transmitting to said mobile device said input data (Figure 7, 180);
- said input being rendered by the specific printer at the location of said mobile device as the permanent record of said service.

See specification, page 4, line 16 to page 5, line 4 and page 9, line 10 to page 10, line 14.

According to the method the data that will be sent to a specific printer is processed in a manner to produce the optimal quality print for the specific printer. The method of applicants recited in claim 1 requires the step (E) of processing, at the printing server, said service data and stored print data for the identified specific printer to generate input data for the specific printer in a manner *to produce the optimal quality print for the specific printer*. The other appealed method claims, namely claim 2, 3, 5, 7, 9, 11, 12 and 17 are dependent upon claim 1 either directly or indirectly and thus include the limitation of producing the optimal quality print for a specific printer.

Claim 18 is directed to a system of providing a service at a mobile device and generating, at the location of said mobile device, a permanent record of said service, said service and said permanent record being processed by at least one of a plurality of remote servers, said system comprising:

means for receiving at a receiving center (Figure 1, 12, 25a, 25b), from the mobile device (Figure 1, 10), a request for the service and information identifying a specific printer (Figure 1, 15) on which service related data is to be printed at the location of the mobile device; and

means for providing, from the receiving center (Figure 1, 12), data for the request to a service server (Figure 1, 70), said service server being one of said at least one of a plurality of remote servers; and

means for processing the request for service at the service server (Figure 1, 70), said processing generating the data for the service; and

means for providing said data for the service to a printing server (Figure 1, 50), said printing server being one of said at least one of a plurality of remote servers and including stored print data (Figure 1, 55) for optimizing the quality of prints printed on various specific printers;

means for processing, at the printing server (Figure 1, 50), said service data (Figure 1, 75) and stored print data (Figure 1, 55) for the identified specific printer to generate input data for the specific printer in a manner *to produce the optimal quality print for the specific printer*; and

means for transmitting to said mobile device said input data, said input being rendered by the specific printer at the location of said mobile device (Figure 1, 10) as the permanent record of said service.

See specification, page 9, line 10 to page 10, line 14.

The other appealed system claims, namely claims 19, 20, 22 to 24, 30, are dependent upon claim 18 either directly or indirectly and thus include the limitation of a means for producing the optimal quality print for a specific printer.

As required under 35 U.S.C. § 41.37(c)(v), for each independent claim involved in the appeal (claims 1 and 18) and for each dependent claim argued separately (none herein argued separately), appellants are required to identify every means plus function and step plus function and the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawing, if any, by reference characters:

Claim	Means plus function or step plus function	Structure, material, or acts described in specification as corresponding to each claimed function	Citation in specification and drawings
18	means for receiving at a receiving center, from the mobile device, a request for the service and information identifying a specific printer on which service related data is to be printed at the location of the mobile device	The receiving center utilized in the above methods can be a receiving server. The receiving server can be the service server or the printing server or a separate server. The receiving center utilized in the above methods can also be a voice portal.	Page 5, lines 16 to 20; Figure 1, 12, 25a, 25b; Figure 1, 10; Figure 1, 15
18	means for providing, from the receiving center, data for the request to a service server, said service server being one of said at least one of a plurality of remote servers	The request for the service can be generated via a voice portal, a telephone call to a receiving center, or via a Web enabled telephone network. The service can be the purchase of a ticket (where the ticket can be an event ticket or a airline, train or bus ticket), the obtaining of a coupon, the obtaining of maps for a specific region, or the obtaining of specific information such as restaurant reviews, menus, short reports. The services can be location based or not location specific.	Page 6, lines 1 to 6 Figure 1, 12; Figure 1, 70
18	means for processing the request for service at the service server, said processing generating	The request is received by a receiving unit 25 (step 200) which can be a telephone 25a or a router 25b depending on whether the network is a voice network or a web enabled network. From the receiving	Page 6, lines 1 to 6; page 9, line 15 to Figure 1, 12; Figure 1, 70;

Claim	Means plus function or step plus function	Structure, material, or acts described in specification as corresponding to each claimed function	Citation in specification and drawings
	the data for the service	center 12, data for the request is provided to a service server 70 (step 210). The transmission of data from the receiving center 12 to the service server 70 can occur in different modes depending on the physical details of connection between the receiving center 12 and the service server 70. If the service server 70 is collocated with the receiving center 12, and the request was sent to the receiving center 12 via a voice portal or via voice, the receiving center 12 and the service server 70 could be connected by a local network. (If the request was sent via voice, an operator is likely to be involved in inputting the request into a computer system.) If the service server 70 is located at a remote location, the receiving center 12 and the service server 70 can be connected by a TCP/IP network. Once data for the request is received at the service server 70, the request for service is processed at the service server 70 (step 110). The processing of the request data generates the data for the service. The processing of the request data can comprise completing a transaction at a transaction server 80 (step 130). The exchange of data between the service server 70 and the transaction server 80 occurs through a network using a secure protocol (HTTPS, which is Secure HTTP, or Secure Socket Layer, SSL, for example).	Figure 1, 12, 25, 25a, 25b, 70, 80, 110
18	means for providing said data for the service to a printing server, said printing server being one of said at least one of a plurality of remote servers and including stored print data for optimizing the quality of prints printed on various	TCP/IP network The transmission between the service server 70 and the printing server 50 occurs via the TCP/IP network 60	Page 15, lines 21 to 22; Figure 1, 50, 60, 70

Claim	Means plus function or step plus function	Structure, material, or acts described in specification as corresponding to each claimed function	Citation in specification and drawings
	specific printers		
18	means for processing, at the printing server, said service data and stored print data for the identified specific printer to generate input data for the specific printer in a manner to produce the optimal quality print for the specific printer	<p>Referring to FIG. 12, the printer database 400 comprises the name of the printer manufacturer 410, the printer model number 420, the printer imaging profile object 430, any other printer descriptor 440 and image processing descriptors 450. The methods described in U.S. Pat. No. 6,128,415 are used to define the printer imaging profile object 430. The printer imaging profile object 430 includes the printer resolution, the printed image size, printer spatial characteristics such as the Modulation Transfer Function and the Noise Power Spectrum, and printer color characteristics (if applicable). Image processing descriptors 450 provide preferences in rendering the image such as halftoning algorithms used and the parameters of such algorithms. Using the data in printer database 400 for a specific printer and the methods U.S. Pat. No. 5,694,484, an image of optimum perceptual quality can be obtained.</p> <p>Using the data in service database 500 for a specific service, the input data for generating a printed record is produced. This input data is processed according to the data in printer database 400 for a specific printer and the methods U.S. Pat. No. 5,694,484 to produce the print data sent to the printer 15 to create an image which is the printed record of the service.</p>	<p>Page 13, line 16 to page 14, line 13</p> <p>Figure 1, 50, 55, 75; Figure 12, 400, 410, 420, 430, 440, 450; Figure 13, 500</p>
18	means for transmitting to said mobile device said input data, said input being rendered by the specific printer at the location of said mobile device as the permanent record of said service	The printing server 50 interacts with the mobile device 10 via network 20. Network 20 can be a WAP network, an i-mode network, or any other web enabled mobile network. If the device 10 is a WAP enabled device, the network 20 includes a WAP gateway (not shown) that serves an interface between the Internet service at the printing server 50 and the WAP-enabled device 10. If the device 10 is an i-mode phone, network 20 is a	<p>Page 14, lines 1 to 13; page 21, line 21 to page 22, line 6;</p> <p>Figure 1, 10, 15, 20</p>

Claim	Means plus function or step plus function	Structure, material, or acts described in specification as corresponding to each claimed function	Citation in specification and drawings
		<p>packet switched network and includes an i-mode center server (also not shown) that converts between the HTTP protocol and the reduced protocol accepted by the device 10. Communication between the device 10 and the printing server 50 takes place via request and response sequences as in an HTTP network.</p> <p>The system can be enabled to transmit over network 20 using protocols such as WAP, the DoCoMo I-mode protocol, or any subsequent standard and use a mark up language such as WML, c-HTML , XHTML or any subsequent standard for mark up languages.</p> <p>Any form of conversion from the reduced mark up language and protocol can be used and the conversion system, such as the WAP gateway or the I-mode center server, can be incorporated into the receiving server 17. Any configuration that enables the information to flow between the receiving server 17 and the mobile device 10 can be used.</p> <p>Referring to FIG. 13, the service database 500 comprises the name of the service 510, the printed record data object 530, other printed items 540, and security item preference descriptors 550. The printed record data object 530 comprises the format of the printed record, and other data needed to generate the printed record. The format includes the objects on the printed page (the printed record) and their location in the page. Other printed items 540 include advertisement Fig.s included or graphics included. Security item preference descriptors 550 include the type of security item, such as bar code, digital watermark, a security image, and the data needed to generate the security item. Using the data in service database 500 for a specific service, the input data</p>	

Claim	Means plus function or step plus function	Structure, material, or acts described in specification as corresponding to each claimed function	Citation in specification and drawings
		for generating a printed record is produced. This input data is processed according to the data in printer database 400 for a specific printer and the methods U.S. Pat. No. 5,694,484 to produce the print data sent to the printer 15 to create an image which is the printed record of the service.	

The novel combination of elements defining the claimed method and system of the present invention not only *print out a record of a service on a specific printer at the location of the mobile device* but, in addition, are configured to process the data to provide an *optimal quality print for the specific printer*.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

There are four issues in this appeal:

- A. Whether claims 1 to 3, 5, 7, 9, 11, 12, 17 to 20, 22 to 24 and 30 are unpatentable as obvious under 35 U.S.C. § 103(a) over WO 01/03040 (“Klear application”) in view of US-B1-6,553,240 (“Dervarics patent”) in view of US 2002/0065873 (“Ishizuka application”).
- B. Whether claims 4, 8, 13 to 15, and 25 to 28 are unpatentable as obvious under 35 U.S.C. § 103(a) over the Klear application in view of Dervarics patent and Ishizuka application and further in view of US-B2-6,725,051 (“Fidler patent”).
- C. Whether claims 1 to 3, 5, 7, 9, 11, 12, 17 to 20, 22 to 24 and 30 are unpatentable as obvious under 35 U.S.C. § 103(a) over the Klear application in view of the Dervarics patent in view of US-A-5,694,484 (“Cottrell patent”).

- D. Whether claims 4, 8, 13 to 15, and 25 to 28 are unpatentable as obvious under 35 U.S.C. § 103(a) over the Klear application in view of the Dervarics patent in view of the Cottrell patent and further in view of the Fidler patent.

7. ARGUMENTS

A. Rejection under 35 U.S.C. § 103(a) over the Klear application in view of the Dervarics patent in view of the Ishizuka application

Claims 1 to 3, 5, 7, 9, 11, 12, 17 to 20, 22 to 24 and 30 are not obvious under 35 U.S.C. § 103(a) over the Klear application in view of the Dervarics patent in view of the Ishizuka application because the combination does not disclose, teach, or suggest the claimed invention.

Appellants' invention is directed a method and system for providing users of mobile digital devices the opportunity to obtain a permanent record of a service originating at the mobile device and not related to the location of the device. The claimed method provides a service at a mobile device and generates, at the location of the mobile device, a permanent record of the service, the service and the permanent record being processed by at least one of many remote servers. According to the claimed method, the data that will be sent to a specific printer is processed in a manner to produce the optimal quality print for the specific printer. The novel combination of elements defining the claimed method and system of the present invention not only print out a record of a service on a specific printer at the location of the mobile device, but, in addition, are configured to process the data to provide an optimal quality print for the specific printer.

The method of independent claim 1 requires the step of:

- (E) processing, at the printing server, said service data and stored print data for the identified specific printer to generate input data for the specific printer in a manner to produce the optimal quality print for the specific printer.

Method claims 2, 3, 5, 7, 9, 11 and 12 are dependent upon claim 1, either directly or indirectly, and thus include the limitation of producing the optimal quality print for a specific printer.

The system of independent claim 18 includes a comparable limitation:

- (E) means for processing, at the printing server, said service data and stored print data for the identified specific printer to generate input data for the specific printer in a manner to produce the optimal quality print for the specific printer.

System claims 19, 20, 22 to 24 and 30 are dependent upon claim 18, either directly or indirectly, and thus include the same limitation.

At page 11, lines 11 to 24 of the present Specification, appellants have described in detail techniques for producing an image of optimal quality at the specific printer. These techniques include ***image processing*** described and claimed in three patents: US-A-5,684,484, US-A-6,128,415, and US-B-6,937,365, which were incorporated by reference into the specification as filed. The Office asserts that the broadest reasonable interpretation of this limitation is “any data which can be utilized to optimize print data for a particular printer.” Examiner’s Answer, page 17. Appellants disagree with this interpretation and assert that the ordinarily skilled artisan would interpret this phrase differently, especially when viewed in light of the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005). See also *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

Contrary to the assertion in the Answer, reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from ‘reading limitations of the specification into a claim,’ to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.” *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). Rather, in a proper interpretation of a limitation, the Office should apply to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification.” *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) (The Board’s construction of the claim limitation “restore hair growth” as requiring the hair to be returned to its original state was held to be an incorrect interpretation of the limitation. The court held that, consistent with applicant’s disclosure and the disclosure of three patents from analogous arts using the same phrase to require only some increase in hair growth, one of ordinary skill would construe “restore hair growth” to mean that the claimed method increases the amount of hair grown on the scalp, but does not necessarily produce a full head of hair.).

Appellants submit that the phrase “optimal quality print,” while not explicitly defined in the specification, would be construed by an ordinarily skilled artisan to involve image processing and means more than mere formatting, as urged by the Office. On page 11, lines 11 to 24 of the present specification, appellants have described in detail techniques for

producing an image of optimal quality at a specific printer. These techniques include image processing described and claimed in US-A-5,684,484, US-A-6,128,415, and US-B-6,937,365, the disclosures of which were incorporated by reference into the subject application. For example, US-B-6,937,365 discloses the use of adaptive halftoning.

While the subject application does not explicitly define “optimal quality print” in the specification, the patents referenced above and incorporated into the specification of the subject application by reference describe and define what is meant by “optimal quality print.” For example, US-A-5,684,484 at column 3, lines 25 to 57 describes image quality as:

The image quality is principally defined by four image parameters: image sharpness, graininess, tonal rendition and color rendition. This is not meant to be a limiting definition in that size, borders, surface gloss, scene content also play a role. The four principal image parameters can be quantified by objective metrics and measured in the laboratory. For example, the sharpness of an imaging device may be characterized by its modulation transfer function, the granularity by its Wiener spectrum, its tonal reproduction by its characteristic curve and its color reproduction by a color difference metric such as ΔE^* of the L^* , a^* , b^* color specification system.

It is most advantageous to select objective metrics that correlate with the human observation of the quality of the image. Thus, one can advantageously select a sharpness metric that “eye weights” the characterizing modulation transfer function sharpness data as described below. Many such metrics have been proposed that correlate with the subjectively defined image quality. One such metric, which will be described later, is a subjective quality value, or “SQV.” Likewise one can characterize each of the four major image quality variables with objective metrics which correlate with image quality. One can calculate the overall system objective metric given the characteristic metrics of the input device, the output device and the image processing steps involved in the chain. Given the characterization of the system metrics for the four principle objective metrics, we then calculate the image quality expected for such an image based on our previously defined correlations relating subjectively defined image quality to these objective metrics. Since the system as defined above contains the image processing steps, which are parametrically controlled, it is possible to search out an optimum set of parameters.

Thus, producing optimal quality prints, as recited in the claims, involves image processing and not merely formatting print data for a specific printer, as is accomplished by a printer driver.

Appellants submit that the Office has not established that the claimed invention is *prima facie* obvious. To establish a proper *prima facie* rejection, the following elements must be shown:

- (1) the reference(s) is (are) available as prior art against the claimed invention;
- (2) the motivation (explicit or implicit) provided by the reference(s), common sense, or common knowledge that would have rendered the claimed invention obvious to one of ordinary skill in the art at the time of the invention;
- (3) a reasonable expectation of success;
- (4) the basis for concluding that the claimed invention would have been obvious to do or obvious to try when there are only a finite number of identified, predictable solutions; and
- (5) the reference(s) teach(es) the claimed invention as a whole.

KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007). Applicant submits that all of the above elements have not been established. Hence, a *prima facie* obviousness rejection is improper.

The Office asserts that Klear discloses a method for providing a service (*i.e.* purchasing tickets to a movie) at a device and generating, at the location of said device a permanent record (*i.e.* bar coded receipt) of said service, said service and said permanent record being processed by at least one of a plurality of remote servers (as shown in Figure 5, reference 26). The Klear application is primarily directed to recording service or transaction data electronically on media such as smart cards and the like, and mentions printing a ticket or a receipt (See, for example, page 10, lines 28 to 32). However, the Klear application does not disclose or in any way suggest that the print data be processed in a manner to produce the

optimal quality print for the specific printer, as is required by the appealed claims. The Office acknowledges that the Klear application does not teach or suggest critical features of appellants' claimed method and system, including that Klear does not disclose that the device is a mobile device and that the input data transmitted to the mobile device is rendered by the specific printer at the location of the mobile device.

The Office turns to the Dervarics patent to supply some of the required missing elements. The Dervarics patent discloses a method to print information from the Internet that allows input data transmitted to the mobile device (*i.e.*, WAP device 100) to be rendered by a specific printer 120 at the location of the mobile device. However, the Dervarics patent, like Klear application, does not disclose or suggest critical features of appellants' claimed method and system.

Dervarics discloses, in Figure 1, a WAP (Wireless Application Protocol) mobile device (such as cell phone 100) that is configured WML (Wireless Markup Language) web page data and internal data such as calendar and phone book information. In Figure 3 and beginning at column 6; line 45 and continuing onto column 7, Dervarics discloses the phone has a print facility integrated into the source code of the operating system software for the cell phone. The printing facility is shown in block diagram form in Figure 3. At column 7, starting at line 12, Dervarics states that:

A printing module 304 contains a printer buffer 304-1 and printing routines 304-2. The printing routines 304-2 are preferably part of the browser, but utilize the appropriate application programming interface (API) of the operating system software to implement the printing facility of the mobile phone.

At column 7, beginning at line 23, it is disclosed that

...the character width of the display 207 controlled by the display module 303 is typically much narrower than the character width of the printing facility controller by printing module 304. WML decoder 301 makes the necessary conversions and wrap-arounds so that the decoded WML data displayed on display 207 can be suitably printed.

It is clear that Dervarics discloses the use of software, within the cell phone, to convert the narrowly formatted WML data for the display to a wider width that is compatible with an identified local printer at the location of the cell phone.

However, the Dervarics patent, like the Klear application, does not disclose, teach or suggest the methods and systems set forth in the present claims wherein information identifying a specific local printer is sent to the remote servers at the service provider via the mobile device; a remote printing server has stored print data for optimizing the quality of print printed on a specific printer; and the printing server processes service data and stored print data for the identified specific printer in a manner to produce the optimal quality print for the specific printer using image processing, such as described in US-A-5,684,484, US-A-6,128,415, and US-B-6,937,365. To the contrary, the Dervarics patent focuses on WAP capable mobile devices and at column 3, starting at line 45 states

The WAP device 100 differs from the personal computer with internet browser 139 in that it generally has a less powerful CPU, less memory, restricted power consumption, smaller displays and more limited network devices.

Because the Dervarics patent performs print data processing locally in the limited resource cell phone, it is clear that the phone does not have the capacity to do the type of print optimization process required by appellants' claimed method and system. Dervarics patent does not disclose, teach, or suggest the concept of doing computer intensive print optimization processing on high capacity remote servers operated by the service provider.

The Office acknowledges the deficiency in the combination of the Dervarics patent and the Klear application, explaining that the combined teachings of the two references does not specifically disclose receiving information identifying a specific printer on which to print the permanent record, and the printing server including stored print data for optimizing the quality of prints printed on various specific printers. The Office, therefore, relies on the Ishizuka application to provide the missing teaching, noting that the Ishizuka application discloses another method to print information off the Internet which includes receiving information identifying a specific printer on which to print the permanent record (*e.g.* abstract “printer selected by the user” paragraph [0048]) as well as the printing server including stored print data for optimizing the quality of prints (*i.e.*, printer drivers for interfacing the software with the printer, this is considered “print data for optimizing the quality of prints” since the driver allows the print data to be formatted appropriately for the type and size of printer) printed on various specific printers (Figure 4, reference 413; Figure 6, reference 607; paragraph [0049]).

The Office concludes that it would have been obvious to one of ordinary skill in the art to combine the teaching of the Ishizuka application with the teachings of the Klear application and Dervarics patent to provide the user the ability to print to a printer which is not earlier known to the user such that the server has the ability to adapt to the user allowing greater flexibility and increasing the user’s ability to utilize the system. This conclusion is based on an erroneous interpretation of the teaching of Ishizuka in relation to the presently claimed method and system. The Ishizuka application does not disclose, teach, or suggest producing “optimal quality print for the specific printer” within the meaning of that language, as used in the present claims.

Independent claims 1 and 18 and their dependent claims require producing an optimal quality print for a specific printer. “Optimal quality print” means more than mere formatting, as urged by the Office. The Ishizuka application, at best, discloses only the use of a printer driver to format print data for a specific printer. The Ishizuka application, like the Klear application and the Dervarics patent, fails to disclose, teach, or suggest a critical claim feature of producing optimal quality prints for a specific printer in accordance with the claimed method and system.

In order to properly support a rejection under 35 U.S.C. § 103(a) the reference or references relied upon to support the rejection must place the claimed subject matter in the possession of the general public. The reference(s) must provide some teaching or suggestion which would enable those skilled in the art, in conjunction with their knowledge of the state of the art, to know of the claimed invention. It has been shown that the references do not teach or in any way suggest a critical feature of appellants’ claimed method and system. Here, only the disclosure of appellants’ specification is sufficient to make the claimed subject matter known to the public.

Further, the only way that the cited references could be said to teach appellants’ claimed subject matter would be to take from each of them, in light of appellants’ specification, only so much of their respective disclosures as would support the rejection. Even then, however, critical limitations are missing, as described above. Such hindsight reconstruction of the prior art is not permissible within the meaning of 35 U.S.C. § 103(a).

Since the combined teachings do not result in the claimed invention, appellant submits that a *prima facie* case of obviousness has not been established. Accordingly, appellant requests withdrawal of the rejection of claims 1 to 3, 5, 7, 9, 11, 12, 17 to 20, 22 to 24 and 30 under 35 U.S.C. §103(a) as allegedly obvious over the Klear application in view of the Dervarics patent in view of the Ishizuka application.

B. Rejection under 35 U.S.C. § 103(a) over the Klear application in view of Dervarics patent and Ishizuka application and further in view of the Fidler patent

Claims 4, 8, 13 to 15, and 25 to 28 are not obvious under 35 U.S.C. § 103(a) over the Klear application in view of Dervarics patent and Ishizuka application and further in view of the Fidler patent because the combination does not disclose, teach, or suggest the claimed invention.

Claims 4, 8, and 13 to 15 are dependent upon claim 2, directly or indirectly. Claim 25 is dependent upon claim 24 and claims 25 to 28 are dependent upon claim 24.

These claims are patentably distinguishable for the same reasons discussed above with respect to the Klear application, Dervarics patent, and Ishizuka application and further because Fidler patent does not teach or suggest critical required features of appellants' claimed method and system, including producing the optimal quality print for a specific printer.

The embodiment of appellants' invention recited in these claims extends the capability of their method and system to encompass location based services. Such location based services

require the selected service provider to obtain the geographic location of the mobile device carried by a user. Once located the service provider can provide local information such as the names, locations, and menus for restaurants close to the user or the location of movie theaters in the vicinity of the user. This group of claims has, in addition to the optimal quality print limitation, a commonality in that they include limitations that are directed to the location-based service aspects of the invention.

The Fidler patent is directed to a method for obtaining location data for use by a peripheral device. As set forth at column 2 beginning at line 50, the method is described as including the steps of communicating with a second device via a wireless protocol and querying the second device for location data. To one having ordinary skill in the art, the Fidler patent would appear to be a diagnostic tool for a network administrator. In contrast, claims 4, 8, and 13 to 15 are directed to an interactive service in which a user requests a location based service (such as nearby restaurants) from a service provider that needs the location of the mobile device to provide the user with appropriate location based service. The method of Fidler does not teach, or even remotely suggest, providing the interactive dialog between a user and service provider to obtain a location based service for the user, and also to allow the user to make an optimal quality printed record of the service at the location of the mobile device.

Since the combined teachings do not result in the claimed invention, appellant submits that a *prima facie* case of obviousness has not been established. Accordingly, appellant requests withdrawal of the rejection of claims 4, 8, 13 to 15, and 25 to 28 as obvious under 35 U.S.C. § 103(a) over the Klear application in view of the Dervarics patent and the Ishizuka application and further in view of the Fidler patent.

C. Rejection under 35 U.S.C. § 103(a) over the Klear application in view of the Dervarics patent in view of the Cottrell patent

Claims 1 to 3, 5, 7, 9, 11, 12, 17 to 20, 22 to 24 and 30 are not obvious under 35 U.S.C. § 103(a) over the Klear application in view of the Dervarics patent in view of the Cottrell patent because the combination does not disclose, teach, or suggest the claimed invention.

These claims are patentably distinguishable for the same reasons discussed above with respect to the combination of the Klear application, Dervarics patent, and Ishizuka application because the Cottrell patent, when combined with the teachings of the Klear application and Dervarics patent, does not disclose, teach or suggest critical required features of appellants' claimed method and system, including producing the optimal quality print for a specific printer.

The Office turns to the Cottrell patent to supply the missing elements reasoning that it would have been obvious to one of ordinary skill in the art to combine the teaching of the Cottrell patent with the Klear application and Dervarics patent to provide an optimal print quality for a plurality of downstream devices without having to guess at how much to adjust the image to achieve an optimal image output by the rendering device. The Cottrell patent, which is cited in appellants' specification as a technique for generating optimal quality according to the invention, discloses an image processing system that automatically optimizes the perceptual quality of images undergoing a series of selected image processing operations. The Office has, in essence, taken one aspect of the Cottrell patent, out of the context of the overall teaching of the reference to support the rejection. The reference discloses a system that includes a set of image-processing operations and involves, among other features, the

generation of psychovisually optimized image data. It is in this context that the Cottrell patent teaches the optimization of images.

The rejection relies upon taking from each reference only a part of the disclosure out of the entirety thereof in order to support the rejection. Such hindsight reconstruction of the prior art is not permissible within the meaning of 35 U.S.C. § 103(a). Here, those skilled in the art would find no incentive in the teachings of the references to modify their disclosures to arrive at appellants' claimed method or system.

Since the combined teachings do not result in the claimed invention, appellant submits that a *prima facie* case of obviousness has not been established. Accordingly, appellant requests withdrawal of the rejection of 1 to 3, 5, 7, 9, 11, 12, 17 to 20, 22 to 24 and 30 are not obvious under 35 U.S.C. § 103(a) over the Klear application in view of the Dervarics patent in view of the Cottrell patent.

D. Rejection under 35 U.S.C. § 103(a) over the Klear application in view of the Dervarics patent in view of the Cottrell patent and further in view of the Fidler patent

Claims 4, 8, 13 to 15, and 25 to 28 are not obvious under 35 U.S.C. § 103(a) over the Klear application in view of the Dervarics patent and the Cottrell patent and further in view of the Fidler patent because the combination does not disclose, teach, or suggest the claimed invention.

These claims are patentably distinguishable for the same reasons discussed above with respect to the Klear application, Dervarics patent, and Cottrell patent and further

because Fidler patent does not overcome the shortcomings of the combined teachings of the Klear application, Dervarics patent, and Cottrell patent, naming a teaching or suggestion of critical required features of appellants' claimed method and system, including producing the optimal quality print for a specific printer.

The Fidler patent relates to a method for obtaining location data for use by a peripheral device including the steps of communication with a second device via a wireless protocol and querying the second device for location data. The embodiment of appellants' invention recited in these claims extends the capability of their method and system to encompass location based services. Such location based services require the selected service provider to obtain the geographic location of the mobile device carried by a user. Once located the service provider can provide local information such as the names, locations, and menus for restaurants close to the user or the location of movie theaters in the vicinity of the user.

This group of claims has, in addition to the optimal quality print limitation, a commonality in that they include limitations that are directed to the location-based service aspects of the invention. Fidler is directed to a method for obtaining location data for use by a peripheral device. As set forth at column 2 beginning at line 50, the method is described as including the steps of communicating with a second device via a wireless protocol and querying the second device for location data. To one having ordinary skill in the art, Fidler would appear to be a diagnostic tool for a network administrator. In contrast, claims 4, 8, 13 to 15, and 25 to 28 are directed to an interactive service in which a user requests a location based service (*e.g.*, nearby restaurants) from a service provider which needs the location of the mobile device to provide the user with appropriate location based service. The method of

Fidler does not disclose, teach, or even remotely suggest providing the interactive dialog between a user and service provider to obtain a location based service for the user and also to allow the user to make an optimal quality printed record of the service at the location of the mobile device.

Since the combined teachings do not result in the claimed invention, appellant submits that a *prima facie* case of obviousness has not been established. Accordingly, appellant requests withdrawal of the rejection of claims 4, 8, 13 to 15, and 25 to 28 as obvious under 35 U.S.C. § 103(a) over the Klear application in view of the Dervarics patent and the Cottrell patent and further in view of the Fidler patent.

Conclusion

For the foregoing reasons, it is respectfully submitted that the Office has not met its burden of establishing that claims 1 to 5, 7 to 9, 11 to 15, 17 to 20, 22 to 28, and 30 are unpatentable as obvious. Appellants, therefore, request that this patent application be remanded to the Patent Office with an instruction to withdraw the rejections of the claims under 35 U.S.C. § 103(a), and allow the appealed claims.

Respectfully submitted,

Date: **October 22, 2007**

/Wendy A. Choi/

Wendy A. Choi

Registration No. 36,697

WOODCOCK WASHBURN LLP
Cira Centre
2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891
Telephone: (215) 568-3100
Facsimile: (215) 568-3439

CLAIMS APPENDIX

The following claims are involved in the present appeal:

1. A method of providing a service at a mobile device and generating, at the location of said mobile device, a permanent record of said service, said service and said permanent record being processed by at least one of a plurality of remote servers, said method comprising the steps of:
 - (A) receiving at a receiving center, from the mobile device, a request for the service and information identifying a specific printer on which service related data is to be printed at the location of the mobile device;
 - (B) providing, from the receiving center, data for the request to a service server, said service server being one of said at least one of a plurality of remote servers;
 - (C) processing the request for service at the service server, said processing generating the data for the service;
 - (D) providing said data for the service to a printing server, said printing server being one of said at least one of a plurality of remote servers and including stored print data for optimizing the quality of prints printed on various specific printers;
 - (E) processing, at the printing server, said service data and stored print data for the identified specific printer to generate input data for the specific printer in a manner to produce the optimal quality print for the specific printer;
 - (F) transmitting to said mobile device said input data,

said input being rendered by the specific printer at the location of said mobile device as the permanent record of said service.

2. The method of Claim 1 wherein the receiving center is a receiving server, said receiving server being one of said at least one of a plurality of remote servers.
3. The method of Claim 1 wherein step (C) further comprises:

completing a transaction at a transaction server, said transaction depending on the requested service, said transaction server being one of said at least one of a plurality of remote servers.
4. The method of Claim 2 further comprising the step of:

receiving at the receiving server, prior to step (C) , data on the location of the mobile device, said data being generated by means for determining the location of the device.
5. The method of Claim 1 further comprising the step of:

sending, after step (C) , to the mobile device, a message confirming that the request for service has been fulfilled.
7. The method of Claim 2 wherein the receiving server is the service server.
8. The method of Claim 4 wherein the receiving server is the service server.
9. The method of Claim 2 wherein the receiving server is the printing server.

11. The method of Claim 1 wherein the requested service is an event ticket.
12. The method of Claim 1 wherein the requested service is a coupon.
13. The method of Claim 4 wherein the requested service is a location based service.
14. The method of Claim 4 wherein said means for determining the location of a device comprise a device based method.
15. The method of Claim 4 wherein said means for determining the location of a device comprise a network based method.
17. The method of Claim 1 wherein the receiving center is a service center.
18. A system of providing a service at a mobile device and generating, at the location of said mobile device, a permanent record of said service, said service and said permanent record being processed by at least one of a plurality of remote servers, said system comprising:
 - means for receiving at a receiving center, from the mobile device, a request for the service and information identifying a specific printer on which service related data is to be printed at the location of the mobile device; and
 - means for providing, from the receiving center, data for the request to a service server, said service server being one of said at least one of a plurality of remote servers; and

means for processing the request for service at the service server, said processing generating the data for the service; and

means for providing said data for the service to a printing server, said printing server being one of said at least one of a plurality of remote servers and including stored print data for optimizing the quality of prints printed on various specific printers;

means for processing, at the printing server, said service data and stored print data for the identified specific printer to generate input data for a- the specific printer in a manner to produce the optimal quality print for the specific printer ; and

means for transmitting to said mobile device said input data, said input being rendered by the specific printer at the location of said mobile device as the permanent record of said service.

19. The system of Claim 18 further comprising:

means for completing a transaction at a transaction server, said transaction depending on the requested service, said transaction server being one of said at least one of a plurality of remote servers.

20. The system of Claim 18 further comprising:

means for sending to the mobile device a message confirming that the request for service has been fulfilled.

22. The system of Claim 18 wherein the requested service is an event ticket.

23. The system of Claim 18 wherein the requested service is a coupon.

24. The method of Claim 18 wherein the receiving center is a receiving server, said receiving server being one of said at least one of a plurality of remote servers.
25. The system of Claim 24 further comprising:
means for receiving, at the receiving server, data on the location of the mobile device, said data being generated by means for determining the location of a device.
26. The system of Claim 25 wherein the requested service is a location based service.
27. The system of Claim 25 wherein said means for determining the location of a device comprise a device based system.
28. The system of Claim 25 wherein said means for determining the location of a device comprise a network based system.
30. The system of Claim 18 wherein the receiving center is a service center.

EVIDENCE APPENDIX

No additional evidence is submitted in the Evidence Appendix.

RELATED PROCEEDINGS APPENDIX

No related appeals or interferences are pending.